UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/143,967	08/31/1998	RANDAL LEE BERTMAN	RP9-95-017V	4218

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Winstead, Sechrest & Minick P.C.
5400 Renaissance Tower
1201 Elm Street
Dallas, TX 75270-2199

EXAMINER
HUYNH, BA

ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	09/143,967	BERTMAN ET AL.
	Examiner	**Art Unit**
	Ba Huynh	2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _20 October 2003_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _38,39,45,46,50,51,57,58,62,63,69,70 and 73-79_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) _46,58 and 70_ is/are allowed.

6)☒ Claim(s) _38-39,45,50-51,57,62-63,69,73-79_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4)☐ Interview Summary (PTO-413) Paper No(s). _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

BA HUYNH
PRIMARY EXAMINER

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   Claims 50-51, 57, 62-63, 69, 73-79 are rejected under 35 U.S.C. 102(e) as being

anticipated by US patent #5,805,911 (Miller).

- As per claims 50, 62: Miller teaches a computer system comprising a housing, a

  processor mounted within the housing for processing digital data, a memory for

  storing digital data, a display, a control program stored in the memory for processing

  of digital data (figures 1-3). The system displays a form defining data fields 35

  (figure 4) and exercises a predictive widget 43-47 (8:39-11:28) to supply a data entry

  for a defined data field 35(9:1-8). The predicted entry is supplied to the data field by

  default (9:1-8).

- As for claims 51, 63: The system store a predictive list of entries (9:25-44) and

  selecting a default entry from the list based on a predetermined algorithm (9:1-8;

  12:53-57).

- As per claims 57, 69: Miller teaches a computer system comprising a housing, a

  processor mounted within the housing for processing digital data, a memory for

  storing digital data, a display, a control program stored in the memory for processing

  of digital data (figures 1-3). The system displays a form defining data fields 35

  (figure 4) and exercises a predictive widget 43-47 (8:39-11:28) to supply a data entry

  for a defined data field 35(9:1-8).   The system store a predictive list of entries (9:25-

  44) and selecting a default entry from the list based on a predetermined algorithm

(9:1-8; 12:53-57). An entry is selected based on weight determination of frequency and recency of use (9:26 – 10:43; 12:3-38).

- As for claim 73: Miller teaches a computer system 12 comprising a memory unit 20 operable for storing a computer program operable for predicting a user's choice in one or more entries in a form (7:59-61), a processor 22 coupled to the memory unit, wherein the processor, responsive to the computer program, comprises circuitry operable for predicting a default user's choice in an entry in the form (1:33-40; 12:58-61), and circuitry operable for predictively filling an entry in the form after the user enters one or more characters in the entry (7:63 – 8:6; 8:56 – 9:8; 9:26-44; 12:49-57).

- As for claims 74, 75, 76: An entry is selected based on weight determination of frequency and/or recency of use (9:26 - 10:43; 12:3-38).

- As for claim 77: The system comprises circuitry operable for presenting the user a list of data entries most likely to be selected by the user (9:42-44; 12:58-67).

- As for claims 78, 79: The list of entries is organized by frequency and/or recency of data entry previously entered by the user (12:61-67).

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 38, 39, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US

patent #5,805,911 (Miller).

- As for claim 38: Miller teaches a computer system comprising a housing, a processor

   mounted within the housing for processing digital data, a memory for storing digital

   data, a display, a control program stored in the memory for processing of digital data

   (figures 1-3). The system displays a form defining data fields 35 (figure 4), and

   exercises a predictive widget 43-47 (8:39-11:28) to supply a data entry for a defined

   data field 35(9:1-8). Miller fails to teach that the system is implemented in a mobile

   computer, however suggested that the system can be implemented in other general

   purpose computers. General purpose mobile computers such as Palmtop and Laptop

   computers are well known the field of data processing (See previously cited US

   patent #5,666,502 (Capps)). It would have been obvious to one of ordinary skill in

   the art, at the time the invention was made, to implement Miller's teaching in a

   mobile computer. Motivation of the implementation is for the desirable advantage of

   the mobility of mobile computers. The predicted entry is supplied to the data field by

   default (9:1-8).

- As for claim 39: Miller teaches a computer system comprising a housing, a processor

   mounted within the housing for processing digital data, a memory for storing digital

   data, a display, a control program stored in the memory for processing of digital data

   (figures 1-3). The system displays a form defining data fields 35 (figure 4), and

   exercises a predictive widget 43-47 (8:39-11:28) to supply a data entry for a defined

   data field 35(9:1-8). Miller fails to teach that the system is implemented in a mobile

computer, however suggested that the system can be implemented in other general purpose computers. General purpose mobile computers such as Palmtop and Laptop computers are well known the field of data processing (See previously cited US patent #5,666,502 (Capps)). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement Miller's teaching in a mobile computer. Motivation of the implementation is for the desirable advantage of the mobility of mobile computers. The predicted entry is supplied to the data field by default (9:1-8). The system store a predictive list of entries (9:25-44) and selecting a default entry from the list based on a predetermined algorithm (9:1-8; 12:53-57).

-   As per claim 45: Miller teaches a computer system comprising a housing, a processor mounted within the housing for processing digital data, a memory for storing digital data, a display, a control program stored in the memory for processing of digital data (figures 1-3). The system displays a form defining data fields 35 (figure 4), and exercises a predictive widget 43-47 (8:39-11:28) to supply a data entry for a defined data field 35(9:1-8). Miller fails to teach that the system is implemented in a mobile computer, however suggested that the system can be implemented in other general purpose computers. General purpose mobile computers such as Palmtop and Laptop computers are well known the field of data processing (See previously cited US patent #5,666,502 (Capps)). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement Miller's teaching in a mobile computer. Motivation of the implementation is for the desirable advantage of the mobility of mobile computers. The predicted entry is supplied to the data field by

default (9:1-8). The system store a predictive list of entries (9:25-44) and selecting a

default entry from the list based on a predetermined algorithm (9:1-8; 12:53-57). An

entry is selected based on weight determination of frequency and recency of use (8:56

– 9:8; 10:33-43; 11:1-7; 12:3-38).

4.   Claims 38, 39, 45, 50, 51, 57, 62, 63, 69, 73-79 are rejected under 35 U.S.C. 103(a) as

being unpatentable over US patent #5,666,502 (Capps), in view of US patent #5,805,911

(Miller).

-       As per claims 38, 50, 62: Capps teaches a handheld computer system comprising a

        housing, a processor mounted within the housing for processing digital data, a

        memory for storing digital data, a display, an input digitizer, a control program stored

        in the memory for processing of digital data (figures 1, 2; col. 4, line 39 – col. 5, line

        52). The system displays a form defining data fields (figure 5a) and exercises a

        predictive widget (9:65 – 10:32; 11:32 – 12:24) to supply a list of predicted data

        entries for a defined data field 184 with the top item in the list being the highest

        ranked data entry to be selected (figures 5b). Capps fails to clearly teach that an entry

        is selected by default. In the same field of providing data entry into a data field using

        predictive modules, Miller discloses the prediction of data entries into data fields

        (1:33-41; 9:25-43). Miller suggested that a predicted data entry can be displayed to

        the user for selection or can be automatically selected by default for entry into a data

        field (9:42-45; 12:49-61). Thus it would have been obvious to one of skill in the art,

        at the time the invention was made, to combine Miller's teaching of default selection

to Capps' for automatically selecting the highest entry in the list 200 as a default

entry into the data field 184, as suggested by Miller.

- As for claims 39, 51, 63: Capps teaches a handheld computer system comprising a

housing, a processor mounted within the housing for processing digital data, a

memory for storing digital data, a display, an input digitizer, a control program stored

in the memory for processing of digital data (figures 1, 2; col. 4, line 39 – col. 5, line

52). The system displays a form defining data fields (figure 5a) and exercises a

predictive widget (9:65 – 10:32; 11:32 – 12:24) to supply a list of predicted data

entries for a defined data field 184 with the top item in the list being the highest

ranked data entry to be selected (figures 5b). Capps fails to clearly teach that an entry

is selected by default. In the same field of providing data entry into a data field using

predictive modules, Miller discloses the prediction of data entries into data fields

(1:33-41; 9:25-43). Miller suggested that a predicted data entry can be displayed to

the user for selection or can be automatically selected by default for entry into a data

field (9:42-45; 12:49-61). Thus it would have been obvious to one of skill in the art,

at the time the invention was made, to combine Miller's teaching of default selection

to Capps' for automatically selecting the highest entry in the list 200 as a default

entry into the data field 184, as suggested by Miller. The system stores a predictive

list of entries (Capps' 11:21-31; figures 6A,B) and proposes a default entry from the

list based on a predetermined algorithm (11:31-61). In light of the combining, the

proposed default entry is automatically selected by default for the data field.

- As for claims 45, 57, 69: Capps teaches a handheld computer system comprising a housing, a processor mounted within the housing for processing digital data, a memory for storing digital data, a display, an input digitizer, a control program stored in the memory for processing of digital data (figures 1, 2; col. 4, line 39 – col. 5, line 52). The system displays a form defining data fields (figure 5a) and exercises a predictive widget (9:65 – 10:32; 11:32 – 12:24) to supply a list of predicted data entries for a defined data field 184 with the top item in the list being the highest ranked data entry to be selected (figures 5b). Capps fails to clearly teach that an entry is selected by default. In the same field of providing data entry into a data field using predictive modules, Miller discloses the prediction of data entries into data fields (1:33-41; 9:25-43). Miller suggested that a predicted data entry can be displayed to the user for selection or can be automatically selected by default for entry into a data field (9:42-45; 12:49-61). Thus it would have been obvious to one of skill in the art, at the time the invention was made, to combine Miller's teaching of default selection to Capps' for automatically selecting the highest entry in the list 200 as a default entry into the data field 184, as suggested by Miller. The system stores a predictive list of entries (Capps' 11:21-31; figures 6A,B) and proposes a default entry from the list based on a predetermined algorithm (11:31-61). In light of the combining, the proposed default entry is automatically selected by default for the data field. An entry is selected based on weight determination of frequency and recency of use (11:32 12:23).

- As for claim 73: Capps teaches a handheld computer system comprising a housing, a processor mounted within the housing for processing digital data, a memory for storing digital data, a display, an input digitizer, a control program stored in the memory for processing of digital data (figures 1, 2; col. 4, line 39 – col. 5, line 52), circuitries for displaying a form defining data fields (figure 5a) and exercises a predictive widget (9:65 – 10:32; 11:32 – 12:24) to supply a list of predicted data entries for a defined data field 184, wherein the top item in the list being the highest ranked data entry to be selected (figures 5b). Capps fails to clearly teach that an entry is selected by default. In the same field of providing data entry into a data field using predictive modules, Miller discloses the prediction of data entries into data fields (1:33-41; 9:25-43). Miller suggested that a predicted data entry can be displayed to the user for selection or can be automatically selected by default for entry into a data field (9:42-45; 12:49-61). Thus it would have been obvious to one of skill in the art, at the time the invention was made, to combine Miller's teaching of default selection to Capps' for automatically selecting the highest entry in the list 200 as a default entry into the data field 184, as suggested by Miller. Miller further discloses circuitries for predictively filling an entry in the form after the user enters one or more characters in the form (1: 33-51; 8:39 – 9:8). It would have been obvious to one of skill in the art, at the time the invention was made, to further combine Miller's teaching of predictive filling an entry in the form after the user enters one or more characters in the form to Capps's predictive widget. Motivation of the combining is for reducing the list of possible entries to a more accurate list with only entries which

matched the entered characters, thus reducing processing time which is also the goal

set forth by Capps (2:4-13).

- As for claims 74, 75: An entry is selected based on weight determination of

frequency and/or recency of use (11:32 12:23; figures 5, 6).

- As for claim 76: The predictive filling an entry in the form after the user enters one

or more characters in the form is based on a combination of frequency and recency of

data entries previously entered by the user in one or more entries in the form (Miller's

9:26-67, 11:1-27, figure 4; Capps' figures 5, 6).

- As for claim 77: The system includes circuitries for presenting the list of predicted

entries to the user (Capps' figure 5; Miller's 12:58-61). The list comprises data

entries previously entered by the user in one or more entries in the form (Miller's

9:26-67, 11:1-27, figure 4; Capps' figures 5, 6).

- As for claims 78, 79: The list is organized by one of a recency and/or frequency of

data entries previously entered in said form (Miller's 9:26-67, 11:1-27, figure 4;

Capps' 12: 4-23, figures 5, 6).

Allowable Subject Matter

5.   Claims 46, 58 and 70 are allowed.

Response to Arguments

Applicant's arguments filed on 10/20/03 have been fully considered but they are not

persuasive.

REMARKS:

As for claims 38, 39, 50 and 62: Claim 50 recites "exercising a predictive widget to

supply a data entry for a defined data field", "wherein ... the control program is executing on the

processor, in exercising the predictive widget to supply a predictive default entry for the defined

data field". In response to the argument that Miller does not teach the predictive default entry,

the predictive default entry is disclosed by Miller in col. 1, lines 33-35, in col. 9, lines 1-8, etc...

wherein a predicted entry is supplied for the data entry field by default, thus is a predictive

default entry. In response to the applicants' argument that "the predictive default entry must be

supplied prior to the user entering any character", this interpretation is not required from the

language of the claim.   Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, it should be noted that Miller

discloses that "*most recently used (MRU) lists are utilized in text completion applications. The*

MRU list gives a menu of recently used names or files so that they can be quickly opened without

retyping the name" (1:33-39), and "*Alternatively or in addition to displaying text at the end of*

the input text, the predictions may be stored to a prediction list. The prediction list may be

displayed to the user in the form of a graphical pull-down menu" (12:58-61). Thus it appears

Miller does disclose a predictive module that predicted a default entry for a data field without

typing any character into the field.

As for claims 45, 57 and 69, in response to the argument that Miller does not teach

"selecting a data entry from the predictive list based upon a user selected weighted determination

of the recency and frequency of use of listed data entries", Miller teaches a most frequently used

prediction module 43 and a most recently used prediction module 44b. The results of the

predictions are being weighted to determine a best prediction. The best prediction is determined

based on prior record of successful prediction of each module (12:3-12). More weight will be

given to the most frequently used prediction module 43 if prediction module 43 has a higher

record of successful, or vice versa. Therefore the best prediction is a weighted determination of

recency and frequency of use of listed data entries. The best prediction is subjected to be

selected by the user. Thus Miller discloses the invention as recited in claims 57 and 69.

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ba Huynh whose telephone number is (703) 305-9794. The

examiner can normally be reached on Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 872-9306. Any inquiry

of a general nature or relating to the status of this application or proceeding should be directed to

the receptionist whose telephone number is (703) 305-3800.

Ba Huynh
Primary Examiner
Art Unit 2173
December 6, 2003